Remarks

I. Status of claims

Claims 1-20 are pending.

II. Claim rejections under 35 U.S.C. § 103

A. Claims 1-4, 8-10, and 17-19

The Examiner has rejected claims 1-4, 8-10, and 17-19 under 35 U.S.C. § 103(a) over Kinra (U.S. 5,731,991).

1. Independent claim 1

Kinra describes an automated method for evaluating a software product (see col. 1, lines 33-34). In accordance with Kinra's teachings, a software product evaluation system 10 receives product data from a user (see col. 2, lines 57-58, and col. 9, lines 38-47). The product data that is input by the user is in the form of numerical values that are responsive to a number of evaluation statements that are generated by the system (see col. 2, line 66, through col. 3, line 1). "The numerical values received in response to an evaluation statement may represent the capacity of a particular software product to perform functions specified by the statement" (col. 3, lines 9-11). The product data that is input by the user for a given software product is stored in a separate product data file 16 (see col. 3, lines 26-28). An environment creator 18 combines product data for two or more product data files 16 that form a software environment (see col. 3, lines 34-37). The system 10 uses weighting values, which correspond to specific criteria for evaluation, to generate criterion scores for each software product and software environment (see col. 4, lines 28-29).

Kinra does not teach or suggest "collecting multiple sets of performance parameter values corresponding to results of testing each of the product samples at test facilities of each of the suppliers," as recited in independent claim 1. Indeed, the only disclosure in Kinra regarding how a user determines the numerical scores that serve as the basis for generating the criterion scores is that the scores represent the capacity of a software product to perform a

specified function (see col. 3, lines 9-11). In addition, none of the exemplary software product features and functions disclosed in Kinra corresponds to performance parameter values (see, e.g., col. 3, lines 1-21, and col. 4, lines 1-19). Consequently, Kinra does not provide any teaching or suggestion that would have led one skilled in the art at the time the invention was made to collect multiple sets of performance parameter values corresponding to results of testing each of the product samples (which are provided to a purchasing entity by multiple independent suppliers) at the test facilities of each of the independent suppliers.

In his rejection of claim 1, the Examiner has stated that:

> Colum 5 line 6-8, criterion scores (i.e., multiple sets of performance parameter values are collected) are collected by the computer memory. These scores correspond to the results of testing of product samples. – see also column 9, line 42-45.

Contrary to the Examiner's statement, however, the criterion scores do not "correspond to the results of testing of product samples." Instead, the criterion scores correspond to the values obtained "by weighting each numerical value in a product data file 16 or an environment data file 22 with a criterion weighting value 24" (col. 4, lines 33-35). Kinra's disclosure in col. 9, lines 42-45, merely teaches that the "system 10 prompts a user of the system to input numerical values in response to a series of evaluation statements relating to features and functions in a software product." The numerical values input by the user are not the criterion scores generated by the criteria scorer 26. In addition, the disclosure in col. 9, lines 42-45, does not teach or suggest that the user's responses to the statements relating to features and functions in a software product are performance parameter values corresponding to the results of testing the software product. In fact, none of the exemplary software product features and functions disclosed in Kinra corresponds to performance parameter values (see, e.g., col. 3, lines 1-21, and col. 4, lines 1-19).

In his rejection of claim 1, the Examiner also has stated that:

> Kinra does not teach:
>
> at test facilities of each of the suppliers;
>
> However, Official Notice is taken that having test facilities at suppliers is old and well known in the art of supply chain management. Testing and evaluation of products at supplier facilities provides for the necessary quality control and verification so that quality is ensured prior to being shipped from the supplier.

> It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Kinra, regarding providing evaluation of product samples to include the step of providing evaluations of product samples at test facilities of each of the suppliers, because it would ensure products meet quality standards prior to being shipped from the supplier.

This reasoning, however, does not establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a). In particular, claim 1 does not recite "providing evaluations of product samples at test facilities of each of the suppliers," as assumed by the Examiner in his rejection. Instead, claim 1 recites "collecting multiple sets of performance parameter values corresponding to results of testing each of the product samples at test facilities of each of the suppliers" (emphasis added). Therefore, on its face, the Examiner's rejection of claim 1 does not establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a) because it does not include a showing that all the claim limitations are taught or suggested by Kinra or the knowledge generally available to one of ordinary skill in the art (see MPEP § 706.02(j)).

It is noted that the Examiner's assumption that a product supplier typically tests its product at its own facilities does not lead to the conclusion that it would have been obvious to collect multiple sets of performance parameter values corresponding to results of testing each of the product samples (which are provided to a purchasing entity by multiple independent suppliers) at the test facilities of each of the independent suppliers. Therefore, the Examiner has not met his obligation to explain why one skilled in the art at the time the invention was made would have been motivated to modify Kinra's software product evaluation system to collect multiple sets of performance parameter values corresponding to results of testing each of the product samples (which are provided to a purchasing entity by multiple independent suppliers) at the test facilities of each of the independent suppliers.

For these reasons, the Examiner has not provided the requisite factual basis and the requisite motivation to support his deemed conclusion that the features recited in claim 1 would have been obvious to one of ordinary skill in the art at the time of the invention. Therefore, the Examiner's rejection of independent claim 1 under 35 U.S.C. § 103(a) over Kinra should be withdrawn.

2. Claims 2-4 and 8-10

Each of claims 2-4 and 8-10 incorporates the features of independent claim 1 and therefore is patentable over Kinra for at least the same reasons explained above.

Claims 2-4 and 8 also are patentable over Kinra for the following additional reasons.

a. Claim 2

Claim 2 recites that "the collecting comprises testing each of the product samples at the test facilities of each of the suppliers."

In his rejection of claim 2, the Examiner has stated that in col. 4, line 17, Kinra teaches that "collecting multiple sets of performance parameter values comprises testing the product samples." Contrary to the Examiner's statement, however, col. 4, line 17 of Kinra merely discloses that an automated testing criterion of evaluation can be defined by an evaluation statement and an associated numerical value assessing the automated performance testing support provided by a software product that is being evaluated. As explained above, the only disclosure in Kinra regarding how a user determines the numerical scores that serve as the basis for generating the criterion scores is that the scores represent the capacity of a software product to perform a specified function (see col. 3, lines 9-11). In addition, Kinra does not provide any basis for concluding that the user's responses to the statements relating to features and functions in a software product are performance parameter values corresponding to the results of testing the software product. Indeed, none of the exemplary software product features and functions disclosed in Kinra corresponds to performance parameter values (see, e.g., col. 3, lines 1-21, and col. 4, lines 1-19).

The Examiner also has stated that:

> However, Official Notice is taken that having test facilities at suppliers is old and well known in the art of supply chain management. Prequalification of products at supplier facilities provides for the necessary quality control and verification so that quality is ensured prior to being shipped from the supplier.
>
> It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Kinra, regarding providing evaluation of product samples to include the step of providing evaluations of product samples at test facilities of each of the suppliers, because it would ensure

products meet quality standards prior to being shipped from the supplier.

As explained above, the Examiner's assumption that a product supplier typically tests its product at its own facilities does not lead to the conclusion that it would have been obvious to collect multiple sets of performance parameter values corresponding to results of testing each of the product samples (which are provided to a purchasing entity by multiple independent suppliers) at the test facilities of each of the independent suppliers. In order to establish a proper rejection under 35 U.S.C. § 103(a), the Examiner is obligated to explain why one skilled in the art at the time the invention was made would have been motivated to modify Kinra's software product evaluation system to collect multiple sets of performance parameter values corresponding to results of testing each of the product samples (which are provided to a purchasing entity by multiple independent suppliers) at the test facilities of each of the independent suppliers.

For these additional reasons, the Examiner's rejection of claim 2 under 35 U.S.C. § 103(a) over Kinra should be withdrawn.

b. Claim 3

Claim 3 recites that "the testing comprises the purchasing entity controlling the product samples during the testing at the test facilities of each of the suppliers."

Claim 3 incorporates the features of claim 2 and therefore is patentable over Kinra for at least the additional reason explained above in connection with claim 2. Claim 3 also is patentable over Kinra for the following additional reasons.

In support of his rejection of claim 3, the Examiner has stated that col. 6, lines 62-63 of Kinra discloses that "access to testing can be designated (i.e., controlling access to testing of samples – see also column 6, line 59-61). In col. 6, lines 59-63, however, Kinra merely discloses that the access of various users to the software product evaluation system 10 "can be a design choice for system 10." Kinra's software product evaluation system 10 does not perform any testing on software products. It only generates criterion scores for each software product and software environment based on product data that is input by the user in the form of numerical values that are responsive to a number of evaluation statements generated by the system.

The Examiner also has stated that:

> Kinra does not teach where the controlling is provided by the purchasing entity. However, official notice is taken that it is old and well known in the art of supply chain management for a purchasing entity of products to control the testing of said products. The direction and control of testing products by the purchasing entity ensures that standards and criteria of the purchasing entity are being measured against during the test to ensure an appropriate buying decision.
>
> It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Kinra, regarding providing access control of product samples to include the step of where the testing is controlled by the purchasing entity, because it would ensure products are properly qualified/disqualified according the purchasing entity's standards prior to the buying decision.

It may be "old and well known in the art" for a purchasing entity to control the testing of products at its own testing facilities. Indeed, the Background section of the present application describes the standard practice in which a manufacturer performs benchmarking tests on component parts at its own facilities. This practice, however, does not involve the purchasing entity controlling the product samples during the testing of each of the product samples at the test facilities of each of the suppliers of the product samples.

Therefore, on its face, the Examiner's rejection of claim 3 does not establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a) because it does not include a showing that all the claim limitations are taught or suggested by Kinra or in the knowledge generally available to one of ordinary skill in the art (see MPEP § 706.02(j)).

For these additional reasons, the Examiner's rejection of claim 3 under 35 U.S.C. § 103(a) over Kinra should be withdrawn.

c. Claim 4

Claim 4 recites that "the testing comprises the purchasing entity preventing unauthorized access to the product samples during the testing at the test facilities of each of the suppliers."

Claim 4 incorporates the features of claim 3 and therefore is patentable over Kinra for at least the additional reason explained above in connection with claim 3.

d. Claim 8

Claim 8 recites "the testing comprises testing each of the product samples at the test facilities of each of the suppliers under substantially similar test conditions."

Claim 8 incorporates the features of claim 2 and therefore is patentable over Kinra for at least the additional reason explained above in connection with claim 2.

3. Claims 17-19

Independent claim 17 recites features that essentially track the pertinent features discussed above in connection with independent claim 1 and, therefore, claim 17 is patentable over Kinra for at least the same reasons.

Each of claims 18 and 19 incorporates the features of independent claim 17 and therefore is patentable over Kinra for at least the same reasons.

B. Claim 5

The Examiner has rejected claim 5 under 35 U.S.C. § 103(a) over Kinra in view of Schoneker.

Claim 5 incorporates the features of independent claim 1. Schoneker does not make-up for the failure of Kinra to teach or suggest the features of independent claim 1 discussed above. Therefore, claim 5 is patentable over Kinra and Shoneker for at least the same reasons explained above in connection with claim 1.

Claim 5 also is patentable over Kinra and Schoneker for the following additional reasons.

Claim 5 recites that "the testing comprises the purchasing entity maintaining custody of the product samples during the testing at the test facilities of each of the suppliers." In an effort to make-up for the failure of Kinra to teach or suggest the features of claim 5, the Examiner has stated that:

Schoneker teaches:

> wherein the purchasing entity maintains custody of the product samples during testing.
>
> Page 4 paragraph 1 line 1-4, the user of material from a supplier (i.e. the purchasing entity) conducts their own tests on material provided by the supplier to establish the reliability of the supplier's COA's. This would require the purchasing entity maintaining custody of the product samples during testing (rather than the supplier, since it is the supplier's own COA results that are being verified).

The testing described on lines 1-4 of paragraph 1 of page 4, however, is performed at the facilities of the purchasing entity. This teaching has nothing whatsoever to do with the purchasing entity maintaining custody of the product samples during the testing of each of the product samples at the test facilities of each of the suppliers.

For this additional reason, the Examiner's rejection of claim 5 under 35 U.S.C. § 103(a) over Kinra in view of Schoneker should be withdrawn.

C. Claims 6 and 7

The Examiner has rejected claims 6 and 7 under 35 U.S.C. § 103(a) over Kinra in view of Stewart.

Each of claims 6 and 7 incorporates the features of independent claim 1. Stewart does not make-up for the failure of Kinra to teach or suggest the features of independent claim 1 discussed above. Therefore, claims 6 and 7 are patentable over Kinra and Stewart for at least the same reasons explained above in connection with claim 1.

Claims 6 and 7 also are patentable over Kinra and Stewart for the following additional reasons.

Claim 6 recites "removing identification information from the product samples before the testing at the test facilities of each of the suppliers." In an effort to make-up for the failure of Kinra to teach or suggest the features of claim 6, the Examiner has stated that:

> Stewart teaches:
>
> further comprising removing identification information from the product samples before the testing.
>
> Page 2 paragraph 6 line 1-4, a blind test is conducted with expensive perfume (Eau de Gucci). A blind test comprises removing identification information from the product samples before testing. This prevents the tester from being biased either

> for or against the particular sample. In this case removing the identification information from expensive perfume prevents a rating from being assigned that is biased higher than it would be under a blind test, since the tester is unaware the product is expensive. This ensures a product is objectively rated.
>
> Page 3 paragraph 9 line 1-3, chocolate chip cookies are tested with only numbers assigned to them, in this example, a number "28" is assigned to a cookie being tested.
>
> Both Kinra and Stewart address product evaluation, thus both Kinra and Stewart are analogous art.
>
> It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Kinra, regarding providing product testing, to include the step of removing product identification from the product samples, as taught by Stewart, because it would ensure that the product testing was performed objectively.

The contention that Kinra's software product evaluation system and the blind testing of the soap and cookies described in Stewart "address product evaluation" is insufficient to establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a). In this regard, the Examiner is obligated to explain why one skilled in the art at the time the invention was made would have been motivated to modify Kinra's software product evaluation system by removing identification information from the product samples before the testing. The rationale given by the Examiner (i.e., "because it would ensure that the product testing was performed objectively") is not persuasive because it is not reasonable for one skilled in the art at the time the invention was made to assume that the user entering product data into Kinra's software product evaluation system would remove identification information from the product samples before the testing. In particular, assuming for the purpose of argument only that the user of Kinra's system performed testing on the software products, one skilled in the art at the time the invention was made would not have believed that such a user would have removed identification information from the product samples before the testing because such a user reasonably would have been expected to objectively test the product samples since it would have been in the user's interest to do so.

For at least this additional reason, the Examiner's rejection of claim 6 under 35 U.S.C. § 103(a) over Kinra in view of Stewart should be withdrawn.

Claim 7 incorporates the features of claim 6 and therefore is patentable over Kinra and Stewart for at least the same reasons explained above in connection with claim 6.

D. Claims 11-14 and 20

The Examiner has rejected claims 11-14 and 20 under 35 U.S.C. § 103(a) over Kinra in view of Performance Measurement Group (PMG).

Each of claims 11-14 incorporates the features of independent claim 1 and claim 20 incorporates the features of independent claim 17. PMG does not make-up for the failure of Kinra to teach or suggest the features of independent claims 1 and 17 discussed above. Therefore, claims 11-14 and 20 are patentable over Kinra and PMG for at least the same reasons explained above in connection with claims 1 and 17.

Claims 11-14 and 20 also are patentable over Kinra and PMG for the following additional reasons.

Claim 11 recites "transmitting the evaluation report to one or more of the suppliers." In an effort to make-up for the failure of Kinra to teach or suggest this feature of claim 11, the Examiner has stated that:

> PMG teaches:
>
> transmitting the evaluation report to one or more of the suppliers. Page 2 paragraph 7 line 1-5, subscribers can access the benchmarking system to access the system.
>
> Page 2 paragraph 5 line, mini-presentations summarize the benchmarking results and comprise a report that is downloaded (i.e. transmitting).
>
> Both Kinra and PMG deal with comparative assessment related to products, thus both Kinra and PMG are analogous art.
>
> PMG teaches that suppliers receiving a copy of an evaluation report allows them to compare their performance to that of other suppliers (page 2 paragraph 5 line 3-7).
>
> It would have been obvious to one of ordinary skill in the art to modify the teachings of Kinra, regarding providing comparative evaluation reports, to include the step of transmitting this report to one or more of the suppliers, as taught by PMG, because it would allow suppliers to benchmark their performance against that of other suppliers.

The benchmarking reports described in PMG only relate to aspects of new product development performance. These aspects range "from developing technologies and selling product strategy, to bringing new products to market, to managing the return on your entire

portfolio of R&D investment" (see last ¶ of page 1 through first ¶ of page 2). The benchmarking reports have nothing whatsoever to do with an evaluation report that is generated based upon multiple sets of performance parameter values corresponding to results of testing each of the product samples at test facilities of each of multiple suppliers that provided the product samples to a purchasing entity.

In addition, the contention that Kinra's software product evaluation system and the new product development performance described in Stewart "deal with comparative assessment related to products" is insufficient to establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a). In this regard, the Examiner is obligated to explain why one skilled in the art at the time the invention was made would have been motivated to modify Kinra's software product evaluation system to transmit the evaluation report to one or more of the suppliers of the software products being evaluated. The Examiner should address the fact that Kinra's software product evaluation system 10 is designed to generate an evaluation of a software product for end-users of the product, whereas PMG generates benchmarking reports that enable manufacturers to evaluate the performance of their new product development processes.

The Examiner's rationale for combining Kinra and PMG (i.e., "because it would allow suppliers to benchmark their performance against that of other suppliers") is not persuasive because the benchmarking described in PMG has nothing whatsoever to do with performance parameter values corresponding to the results of testing sample products supplied to a purchasing entity by multiple independent suppliers. Therefore, the Examiner has not met his obligation to point to specific locations in the cited references that provide the requisite motivation to combine the references in a way that would have led one skilled in the art at the time the invention was made to the invention recited in claim 11. The Examiner is reminded that he is not permitted to engage in hindsight reconstruction of the claimed invention, using applicants' disclosure as a blueprint for piecing together prior art to defeat patentability. Without a proper explanation for combining the cited prior art, the Examiner cannot establish a proper *prima facie* case of obviousness and the rejection of claim 11 should be withdrawn.

For at least these additional reasons, the Examiner's rejection of claim 11 under 35 U.S.C. § 103(a) over Kinra in view of Stewart should be withdrawn.

Each of claims 12-14 incorporates the features of claim 11 and therefore is patentable over Kinra and PMG for at least the same reasons explained above in connection with claim 11.

Claim 20 recites that the computer program further comprises "computer-readable instructions for customizing the evaluation report so that a supplier receiving the evaluation report is able to benchmark performance of its product sample against other product samples without identifying other suppliers." Claim 20 is patentable over Kinra and PMG for at least the second reason explained above in connection with claim 11.

E. Claims 15 and 16

The Examiner has rejected claims 15 and 16 under 35 U.S.C. § 103(a) over Kinra in view of General Motors Supplier Development General Procedure (GP10).

Each of claims 15 and 16 incorporates the features of independent claim 1. GP10 does not make-up for the failure of Kinra to teach or suggest the features of independent claim 1 discussed above. Therefore, claims 15 and 16 are patentable over Kinra and GP10 for at least the same reasons explained above in connection with claim 1.

Claims 15 and 16 also are patentable over Kinra and Stewart for the following additional reasons.

Claim 15 recites that "the generating comprises compiling a data structure relating corresponding ones of the performance parameter values and respective ones of the supplier test facilities for each of the product samples."

In his rejection of claim 15, the Examiner has stated that:

> Regarding Claim 15, Kinra teaches compiling a data structure relating parameter values for each product sample and providing an evaluation report that provides a comparison of product samples (Column 6 line 7-15 and Figure 2) but does not teach:
>
> wherein generating the evaluation report comprises compiling a data structure relating parameter values and supplier test facilities for each product sample.
>
> GP10 teaches:
>
> compiling a data structure relating parameter values and supplier test facilities for each product sample.

> Page 17 Item B No. 5, product samples are identified and reports identifying the product samples are traced (i.e. tracked and recorded).
>
> Page 5, GP10 teaches that each facility is recorded and qualified as a supplier test facility. Standards are applied to these test facilities to ensure that different test facilities provide as repeatable measurements across these different test facilities as possible (see also page 6 Item 6a where qualification of test equipment is discussed).
>
> Both GP10 and Kinra address product sample evaluation, thus both GP10 and Kinra are analogous art.
>
> GP10 teaches maintaining records and ensuring qualification for supplier test facilities is necessary to ensure traceability for supplier test results (page 17 Item B No. 5).
>
> It would have been obvious to one of ordinary skill in the art to modify the teachings of Kinra, regarding providing comparative evaluation reports, to include the step of including supplier test facility data for individual test samples, as taught by GP10, because it would provide traceability for the test results provided for product samples.

This reasoning, however, does not establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a). In particular, modifying Kinra's software product evaluation system "to include the step of including supplier test facility data for individual test samples" would not have resulted in the invention recited in claim 15. In particular, such a modification would not have resulted in compiling a data structure relating performance parameter values, which correspond to the results of testing each of the product samples at test facilities of each of multiple independent suppliers of the product samples, and respective ones of the supplier test facilities for each of the product samples. Therefore, on its face, the Examiner's rejection of claim 15 does not establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a) because it does not include a showing that all the claim limitations are taught or suggested by Kinra, GP10, or the knowledge generally available to one of ordinary skill in the art (see MPEP § 706.02(j)).

In addition, none of the sections of GP10 that are cited by the Examiner in support of his rejection of claim 15 would have led one skilled in the art to modify Kinra's disclosure to arrive at the invention recited in claim 15. Indeed, section B.5 on page 17 of GP10 merely asks the material test facility to "Describe how samples are identified and reports traced, and

the questionnaire on pages 5 and 6 of GP10 merely asks a supplier to describe aspects of its test facility and testing policies.

For at least these reasons, the Examiner's rejection of claim 15 under 35 U.S.C. § 103(a) over Kinra in view of GP10 should be withdrawn.

Claim 16 incorporates the features of claim 15 and therefore is patentable over Kinra and GP10 for at least the same reasons explained above.

III. Conclusion

For the reasons explained above, all of the pending claims are now in condition for allowance and should be allowed.

Charge any excess fees or apply any credits to Deposit Account No. 08-2025.

Respectfully submitted,

Date: March 4, 2006

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